

Docket No.: 248684US2SRD

COMMISSIONER FOR PATENTS ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/772,280

Applicants: Masahiro KOIKE, et al.

Filing Date: February 6, 2004

For: SEMICONDUCTOR DEVICE AND METHOD OF

MANUFACTURING SEMICONDUCTOR DEVICE

Group Art Unit: 2818 Examiner: Ho, Tu Tu V

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBŁON, SPIVAK, McCLELLAND,

OBLON

SPIVAK

McClelland

MAIER

NEUSTADT P.C.

ATTORNEYS AT LAW

ECKHARD H. KUESTERS

(703) 413-3000

EKUESTERS@OBLON.COM

MAIER & NEUSTADT, P.Ç

Eckhard H. Kuesters

Registration No. 28,870

Customer Number

22850

(703) 413-3000 (phone) · (703) 413-2220 (fax)

1940 DUKE STREET ALEXANDRIA, VIRGINIA 22314 U.S.A. TELEPHONE: 703-413-3000 FACSIMILE: 703-413-2220 WWW.OBLON.COM

DOCKET NO: 248684US2SRD



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

MASAHIRO KOIKE ET AL

: EXAMINER: HO, TU TU V

SERIAL NO: 10/772,280

FILED: FEBRUARY 6, 2004

: GROUP ART UNIT: 2818

FOR: SEMICONDUCTOR DEVICE AND

METHOD OF MANUFACTURING

SEMICONDUCTOR DEVICE

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the election requirement dated April 26, 2006, Applicants provisionally elect with traverse Group I, Claims 1-12 and 21-23, drawn to a semiconductor device having an insulating film, classified in class 257, subclass 410, for further examination on the merits. Applicants reserve the right to file one or more divisional applications directed to the nonelected invention.

Furthermore, while the Election Requirement asserts that the application contains claims to patentably distinct inventions, MPEP § 803 states the following:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Although the outstanding Official Action identifies different search classifications, it is believed that the claims of the present application would have to be searched in a handful of sub-classes. Furthermore, since electronic searching is commonly performed, a search may

Application No. 10/772,280 Reply to Office Action of April 26, 2005

be made of a large number of, or theoretically all, subclasses without substantial additional effort. Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would be a serious burden on Applicants to prosecute and maintain separate applications.

Therefore, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-23 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,

MATER & NEUSTADT, P.C.

Customer Number

22850

Tel: (703) 413-3000 Fax: (703) 413 -2220

I:\ATTY\EHK\AMEND-RESPONSES\0039\24S\248684US-PE.DOC

(OSMMN 08/03)

Eckhard H. Kuesters
Attorney of Record

Registration No. 28,870